

Remarks

Claims 1-15 and 44-49 are pending in the subject application. By this Amendment, Applicants have canceled claims 44-49 and added new claim 50. Support for the new claims can be found throughout the subject specification and in the claims as originally filed (see for example, Figure 1). Entry and consideration of the amendments presented herein is respectfully requested. Accordingly, claims 1-15 and 50 are currently before the Examiner. Favorable consideration of the pending claims is respectfully requested.

Additionally, a Supplemental Information Disclosure Statement was filed in this matter on March 11, 2005. Consideration of the reference and the return of the initialed form PTO/SB/08A is respectfully requested.

Claims 1, 7-10 and 13-15 are rejected under 35 U.S.C. § 102(b) as anticipated by Mak *et al.* (U.S. Patent No. 5,490,415). The Office Action argues that Mak *et al.* teach a device "for measuring the transfer of components across a tissue that includes a support plate (4) that supports an array of donor samples. The device includes a tissue specimen (8) that overlays the array of samples and reservoir plate (6) secured to a side of the tissue specimen opposite the array of samples. The reservoir plate includes an array of reservoirs (26)."

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Further, while identity of terminology is not required, the elements must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Applicants submit that Mak *et al.* fail to teach a support plate upon which an array of samples has been placed. As is indicated in Mak *et al.* (at column 6, lines 50-65), the "receiver receptacles" are filled with a receiver liquid (typically saline); it is respectfully submitted that the "receiver assembly" corresponds to the "support plate" of the subject invention based upon the teachings of Mak *et al.* A membrane is then placed over the receiver and the donor face of the "donor assembly" is placed against the receiver face of the "receiver assembly"; it is respectfully submitted that the "donor assembly" corresponds to the "reservoir plate" of the subject invention. Donor receptacles

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within the "donor assembly" are then filled with a donor liquid that contains a test substance (typically a drug).

As indicated *supra*, the elements of the claim must be arranged as required by the claim. In this case, it is respectfully submitted that the Mak *et al.* fail to teach an apparatus that has a support plate upon which samples are arrayed. Mak *et al.* further fail to teach a tissue specimen that overlays the array of samples that have been loaded onto the sample surface of said support plate. Thus, it is respectfully submitted that the teachings of Mak *et al.* do not anticipate the claimed invention. Applicants further submit that Mak *et al.* cannot anticipate the claimed invention as the reference fails to teach a reservoir plate having an array of reservoirs each reservoir having openings on opposing surfaces of said reservoir plate (see, for example, claim 50).

Applicants also respectfully submit that it also appears that the apparatus of Mak *et al.* may not be functional in an orientation wherein the "donor assembly" corresponds to "support plate" of the subject invention. For example, it appears that air would become entrapped between the membrane and the samples within the donor receptacles of the "donor assembly" when the device is oriented such that the "donor assembly" corresponds to the "support plate" as set forth in the subject invention. In such an event, sample would poorly diffuse (or not diffuse) between the donor assembly and the "receiver assembly". Further, the teachings of Mak *et al.* would appear to require that the device be placed in a substantially horizontal position in order to facilitate diffusion of a test substance (active component) between the two reservoirs (see, for example, Figure 4).

Claims 2-6, 11 and 12 are rejected under 35 U.S.C. § 103(a) as obvious over Mak *et al.* (U.S. Patent No. 5,490,415). The teachings of Mak *et al.* have been discussed *supra* and it is respectfully submitted that the teachings of Mak *et al.* do not raise a *prima facie* case of obviousness for the claimed invention. As noted *supra*, Mak *et al.* fail to teach an apparatus meeting each of the limitations of the subject invention and that Mak *et al.* fail to teach an apparatus containing elements as arranged in the claim. Accordingly, it would not appear that the claimed invention is rendered obvious by the cited reference and reconsideration and withdrawal of the rejection is respectfully requested.

Claims 1-15 are provisionally rejected under the judicially created doctrine of "obviousness-type" double patenting over claims 50-88 of co-pending Application No. 10/282,505. Claims 1-15

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are provisionally rejected under the judicially created doctrine of "obviousness-type" double patenting over claims 1-41 of co-pending Application No. 10/869,234. Claims 1-15 are provisionally rejected under the judicially created doctrine of "obviousness-type" double patenting over claims 16-34 and 39-83 of co-pending Application No. 10/439,943. In view of the terminal disclaimers submitted herewith, it is respectfully submitted that these rejections are now moot and withdrawal of the rejections is respectfully requested.

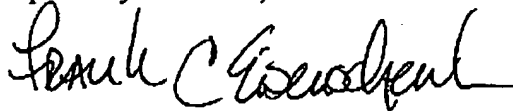
It should be understood that the amendments presented herein have been made solely to expedite prosecution of the subject application to completion and should not be construed as an indication of Applicants' agreement with or acquiescence in the Examiner's position. Applicants expressly reserve the right to pursue the invention(s) disclosed in the subject application, including any subject matter canceled or not pursued during prosecution of the subject application, in a related application.

In view of the foregoing remarks and amendments to the claims, Applicants believe that the currently pending claims are in condition for allowance, and such action is respectfully requested.

The Commissioner is hereby authorized to charge any fees under 37 C.F.R. §§1.16 or 1.17 as required by this paper to Deposit Account No. 19-0065.

Applicants invite the Examiner to call the undersigned if clarification is needed on any of this response, or if the Examiner believes a telephonic interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,



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Attachment: Terminal Disclaimers (3)

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